

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	Group Art Unit: 1732
	)	
Charles A. Byrne	)	Examiner: Matthew J. Daniels
	)	
Serial No. 10/701,052	)	
	)	
Filed: November 3, 2003	)	Docket No. MAMMO-44436
	)	
For: IMPROVED METHOD FOR	)	
MANUFACTURING ANIMAL	)	
CHEW TOY	)	
_____	)	

**APPELLANT'S BRIEF**  
**(37 CFR §1.192)**

Commissioner for Patents  
Via E-File

Gentlemen:

This brief is in furtherance of the Notice of Appeal, filed in this case on July 23, 2007. The fees required under §1.17 for filing this brief are submitted herewith.

**I. REAL PARTY INTEREST**

The real party in interest in the above-identified matter is CB Worldwide, Inc. d/b/a Mammoth Pet Products, a California corporation, pursuant to the October 27, 2003 Assignment by Charles A. Byrne, the inventor.

## **II. RELATED APPEALS AND INTERFERENCES**

There are no prior or pending appeals, judicial proceedings or interferences known to the appellant which may be related to, directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

### **III. STATUS OF CLAIMS**

Claims 1, 3-5 and 7-27 are rejected.

Claims 2 and 6 have been canceled.

There are no claims which have been withdrawn, objected to, or allowed.

#### **IV. STATUS OF AMENDMENTS**

There have been no Amendments filed subsequent to the final rejection.

Applicant believes that all prior Amendments have been entered.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

\_\_\_\_\_. The present invention is directed to a method for manufacturing an animal chew toy. As recited in independent claim 1, first and second layers of rubber material are formed in a general shape and size of the animal chew toy (page 6 lines 10-11, 17, page 7 lines 22-24, page 8 lines 27-28).

A floss material comprising at least one mesh fabric sheet of synthetic fibers formed in the general shape and size of the animal chew toy is placed between the first and second layers of rubber material (page 6 lines 6-9, page 7 lines 1-3, page 7 lines 27-31, and as illustrated in FIGS. 1, 8, and 13).

The sheets of rubber and floss material are molded into the animal chew toy, wherein the molding step includes the steps of compressing the sheets of rubber and floss material between opposing mold members under pressure and heat (page 6 lines 17-22, page 8 lines 4-7, page 8 lines 24-26, and as illustrated in FIGS. 5, 9, 10, and 14-16).

Independent claim 14 further recites that the first and second layers of rubber material are a tire rubber material. Furthermore, claims 4, 15, and independent claim 21 recite that the tire rubber material comprises natural or synthetic rubber mixed with carbon black (page 5 lines 26-27, page 7 lines 16-19).

In a particularly preferred embodiment, the animal chew toy is comprised of such tire rubber material as it has a tire configuration having a diameter of between six and ten inches, without any embedded metal therein, as recited in claim 13. Moreover, the

tire configuration includes an outer periphery having a tread design formed over at least a portion thereof, and spaced apart sidewalls extending inwardly from the outer periphery to define generally aligned central apertures, the periphery in the sidewalls having a generally U-shaped cross-section, as recited in claims 26 and 27. Support for these recitations is found on page 5 lines 21-22, page 6 lines 23-31, page 7 lines 6-8, and FIGS. 6, 7, and 22-24.

Dependent claims 7, 17 and 22 recite the step of attaching a rope to the animal chew toy (page 9 line 31 - page 10 line 7 and as illustrated in FIGS. 22, 24 and 25-27).

Claims 8, 18 and 23 recite the step of retaining an animal treat in a cavity of the animal chew toy (page 8 lines 16-21, page 10 lines 20-22, and as illustrated in FIGS. 28 and 29).

Claims 9, 19 and 24 recite the step of associating a buoyant insert (96, 98 and 108), such as a closed-cell foam, with the animal chew toy (page 7 line 10, page 9 lines 10-18, and page 10 lines 8-11).

As typical tire rubber has a unique and strong smell which might deter some dogs from using the chew toys created by the invention, a scent material may be added to the first and second layers of rubber, as recited in claims 12, 20 and 25, and as described on page 5 line 28 - page 6 line 2.

**VI. GROUND'S OF REJECTION TO BE REVIEWED ON APPEAL**

A. Whether claims 1, 5 and 14 are unpatentable under 35 U.S.C. §103(a) as being unpatentable over Cooper (U.S. Patent No. 6,174,214) in view of Ou (U.S. Patent No. 6,500,082).

B. Whether claims 3-4, 15-16 and 21 are unpatentable under 35 U.S.C. §103(a) as being unpatentable over Cooper (U.S. Patent No. 6,174,214) in view of Ou (U.S. Patent No. 6,500,082) and further in view of Willinger (U.S. Patent No. 6,662,659).

C. Whether claims 12 and 20 are unpatentable under 35 U.S.C. §103(a) as being unpatentable over Cooper (U.S. Patent No. 6,174,214) in view of Ou (U.S. Patent No. 6,500,082) and further in view of Edwards (U.S. Patent No. 4,513,014).

D. Whether claim 25 is unpatentable under 35 U.S.C. §103(a) as being unpatentable over Cooper (U.S. Patent No. 6,174,214) in view of Ou (U.S. Patent No. 6,500,082) and further in view of Willinger (U.S. Patent No. 6,622,659) and Edwards (U.S. Patent No. 4,513,014).

E. Whether claims 7, 9-11, 17 and 19 are unpatentable under 35 U.S.C. §103(a) as being unpatentable over Cooper (U.S. Patent No. 6,174,214) in view of Ou (U.S. Patent No. 6,500,082) and further in view of Markham et al. (U.S. Patent No. 5,904,118).

F. Whether claims 8 and 18 are unpatentable under 35 U.S.C. §103(a) as being unpatentable over Cooper (U.S. Patent No. 6,174,214) in view of Ou (U.S.



Patent No. 6,500,082) and further in view of Markham et al. (U.S. Patent No. 5,832,877).

G. Whether claim 13 is unpatentable under 35 U.S.C. §103(a) as being unpatentable over Cooper (U.S. Patent No. 6,174,214) in view of Ou (U.S. Patent No. 6,500,082) and further in view of Richards (U.S. Patent No. 5, 020,808).

H. Whether claims 22 and 24 are unpatentable under 35 U.S.C. §103(a) as being unpatentable over Cooper (U.S. Patent No. 6,174,214) in view of Ou (U.S. Patent No. 6,500,082) and further in view of Willinger (U.S. Patent No. 6,622,659) and Markham et al. (U.S. Patent No. 5,904,118).

I. Whether claim 23 is unpatentable under 35 U.S.C. §103(a) as being unpatentable over Cooper (U.S. Patent No. 6,174,214) in view of Ou (U.S. Patent No. 6,500,082) and further in view of Willinger (U.S. Patent No. 6,622,659) and Markham et al. (U.S. Patent No. 5,832,877).

J. Whether claim 26 is unpatentable under 35 U.S.C. §103(a) as being unpatentable over Cooper (U.S. Patent No. 6,174,214) in view of Ou (U.S. Patent No. 6,500,082) and Richards (U.S. Patent No. 5,020,808), and further in view of Mitchell (U.S. Patent No. 4,906,007) and Farhi (U.S. Patent No. 3,673,731).

K. Whether claim 27 is unpatentable under 35 U.S.C. §103(a) as being unpatentable over Cooper (U.S. Patent No. 6,174,214) in view of Ou (U.S. Patent No. 6,500,082) and further in view of Mitchell (U.S. Patent No. 4,906,007) and Farhi (U.S. Patent No. 3,673,731).

## VII. ARGUMENT

### 35 U.S.C. §103(a) Rejection of Claims 1, 5 and 14

Claims 1, 5 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cooper (6,174,214) in view of Ou (6,500,082). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing *In re Vaeck*, 20 USPQ 2d 1438 (Fed.Cir. 1991).

Independent claim 1 recites a method for manufacturing an animal chew toy, comprising the steps of providing first and second layers of rubber material formed in a general shape and size of the animal chew toy. A floss material comprising at least one mesh fabric sheet of synthetic fibers formed in a general shape and size of the animal chew toy is placed between the first and second layers of rubber material. The sheets of rubber and floss material are molded into the chew toy by compressing the sheets of rubber and floss material between opposing mold members under pressure and heat.

Independent claim 14 recites similar steps, but specifies that the first and second layers are of a tire rubber material.

The Cooper reference is directed to a flexible waterproof flying disc. A single piece of flexible, non-porous, water impervious material comprising synthetic rubber, and more particularly closed-cell neoprene, defines the generally circular section or generally disc-shaped core 18 of the Cooper flying disc. A first fabric layer is bonded to the upper surface of the core 18, and a second fabric layer is bonded to the lower surface of the core, such that the core is covered by the fabric layers 20 and 22, which conform to the shape of the core (column 3, lines 57-63).

Applicant respectfully asserts that the Cooper reference does not disclose the steps of providing a layer of synthetic fibers, and creating a multi-layer rubber and synthetic fiber sheet by attaching a first sheet of rubber material to a surface of the synthetic fiber layer, and attaching a second sheet of rubber material to an opposite surface of the synthetic fiber layer, as recited in independent claims 1 and 14. Instead, as described above, Cooper discloses providing a closed-cell neoprene center core or body, covered by two sheets of nylon fabric.

Cooper teaches that it intentionally provides a closed-cell neoprene center core or body, covered on upper and lower surfaces thereof by sheets of nylon fabric for various purposes. During use of the flying disc 10 in wet environments, the thin fabric layers protect the core 18 and retain some moisture to give the flying disc sufficient weight to provide the flying disc with realistic dynamic characteristics, such as stability, improved flight performance and improved handling. Additionally, the properties of the

nylon fabric layers enable the retained moisture to be sprayed during flight of the flying disc, providing an aesthetic display during flight as well as further improving its flight performance (column 4, lines 27-40).

As recited in the independent claims of the present invention, and more particularly claims 1 and 14, the at least one mesh fabric sheet of synthetic fibers formed in a general shape and size of the animal chew toy is placed between the first and second layers of rubber material and molded therein so as to be embedded within the sheets of rubber material. The synthetic fibers of the present invention are embedded within the rubber material to provide strength to the rubber material as well as to provide a floss characteristic when the animal chews the chew toy. Cooper discloses that the neoprene disc toy has the fabric layers disposed on an outer surface thereof, so as to protect the core, retain moisture to give the flying disc sufficient weight to provide the flying disc with realistic dynamic characteristics and flight performance, and so as to create a spray effect during flight of the disc. Clearly, Cooper discloses perceived benefits of attaching the fabric layers on an outer surface of the neoprene core, as opposed to embedding the fabric sheet within the neoprene core. In fact, there is no teaching or suggestion or even inference of embedding the nylon sheets within the neoprene core. Applicant respectfully submits that Cooper actually teaches away from the present invention by specifically stating perceived benefits and advantages of having the fabric layers attached to an outer surface of the neoprene core, as discussed above.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970)). Applicant respectfully submits that Cooper fails to provide the teachings relied upon and asserted by the Examiner, as Cooper does not teach, suggest, or even infer a method for manufacturing an animal chew toy including the steps of placing a floss material comprising at least one mesh fabric sheet of synthetic fibers formed in a general shape and size of the animal chew toy between first and second layers of rubber material formed in the general shape and size of the animal chew toy. Instead, applicant respectfully submits that Cooper teaches just the opposite, disposing a closed cell neoprene layer between two layers of mesh fabric in order to achieve completely different results.

In the Office Action, the Examiner admitted that Cooper does not teach a compression molding process for bonding the rubber and fabric sheets. Accordingly, Cooper was combined with Ou, which teaches a compression molding process for creating an American football supported with a construction liner. Ou discusses, in column 3, lines 51-53, that in a preferred embodiment two fabric linings 242 are attached to both sides of a single rubber piece 241. In column 4, lines 3-6, Ou states that more than one rubber piece 241 and/or more than two pieces of fabric linings can be united to form a thicker and/or stiffer construction liner. However, it seems clear from a reading of the Ou reference that it is important that a fabric lining form the lower

most layer, even if multiple layers of rubber and fabric linings are used. The rubber and fabric sheets are cut into elliptical rubber pieces, which are compressed and vulcanized to create the rubber-based fabric liner. Four such construction liners are placed on inner surfaces of cover skins 23 to form four cover pieces, which are sewn together at the edge to form the ball cover. An inflatable rubber bladder is then inserted into the ball cover, and the inlet opening is sewn to form the American football.

As stated by M.P.E.P. §2141.02, in determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Citing, *Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Norton Corp.*, 218 USPQ 698 (Fed. Cir. 1983). The claimed invention must be viewed as a whole. *Bausch & Lomb, Inc.*, 796 F.2d at 449 [230 USPQ at 420] (citing *Jones v. Hardy*, 727 F.2d 1524, 1527-1528, 220 USPQ 1021, 1023-1024 (Fed. Cir. 1984). The proper test in analyzing the prior art is whether the prior art reference, taken as a whole, would have suggested the invention to an ordinary person skilled in the art. *Jones*, 727 F.2d at 1530, 220 USPQ at 1026. Further, a prior art reference must be considered in its entirety, i.e., as a whole including portions that would lead away from the claimed invention. M.P.E.P. §2141.02, citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983), *cert. Denied*, 469 US 851 (1984).

Applicant respectfully submits that when viewed as a whole, the Cooper reference discloses to one of ordinary skill in the art a flexible waterproof lined disc

comprised of closed-cell neoprene having fabric layers bonded to upper and lower surfaces thereof so as to conform to the shape of the core, the fabric layers serving to protect the core, and retain moisture to give the flying disc weight, realistic dynamic characteristics, improved flight performance and handling, and an aesthetically pleasing spray effect during flight. When viewed as a whole, the Ou reference discloses a methodology for manufacturing an American football supported with a construction liner fused to an upper layer of rubber material 241 during a compression molding step, after which the multiple sections must be sewn together, and a bladder inserted therein in order to make the American football.

The teachings of Cooper and Ou are only analogous to one another given the teachings of the present application; otherwise, the references are completely non-analogous. Of course, it is axiomatic that a claimed invention is not obvious solely because it is composed of elements that are individually found in the prior art. *Life Technologies, Inc. v. Clonetech Laboratories, Inc.*, 56 USPQ 2d 1186 (Fed. Cir. 2000).

Aside from being non-analogous to one another, absent the teachings of the present invention, applicant respectfully submits that there is no suggestion or motivation to modify the references or combine the reference teachings as has been proposed by the Examiner. As indicated above, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

As described above, it would be completely contrary to the teachings of Cooper to embed the fabric sheets in the closed-cell neoprene material forming the center core.

Of course, this would be the result if the compression molding teaching of Ou were applied to Cooper. In such case, Cooper's flying disc would not have the fabric layers on the upper and lower surfaces to retain moisture and provide the characteristics indicated as desirable in Cooper. Moreover, those skilled in the art will also appreciate that closed-cell neoprene materials are typically not compression molded by the very nature of the material.

Thus, the Examiner has failed to establish the first basic criteria of a *prima facie* case of obviousness: that there must be some suggestion or motivation in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.01 citing *In re Mills*, 16 USPQ 2d 1430 (Fed. Cir. 1990). An attempted modification of a prior art reference that is unwarranted by the disclosure of that reference is improper. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

However, even if one were to compression mold the closed neoprene core with the outer layers of fabric, as by the proposed combination of Cooper and Ou, this still does not teach the recitations of independent claims 1 and 14, which require that the at least one sheet of floss material be disposed between the first and second layers of rubber material and molded therein using pressure and heat. Thus, applicant respectfully asserts that all of the claim limitations of independent claims 1 and 14 are



not taught or suggested by the proposed combination of Cooper and Ou. Thus, from the foregoing, applicant respectfully asserts that the rejection as to independent claims 1 and 14 is improper and should be withdrawn.

**35 U.S.C. §103(a) Rejection of Claims 3-4, 15-16 and 21**

Claims 3-4, 15-16 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cooper in view of Ou and further in view of Willinger (U.S. Patent No. 6,622,659). These claims are directed to the recitation that the rubber material comprises a tire rubber material. More particularly, claims 4 and 15 recite that the tire rubber material comprises natural or synthetic rubber mixed with carbon black. Willinger (U.S. Patent No. 6,622,659) was combined with the aforementioned patents as neither of these patents teach a tire rubber material mixed with carbon black. Willinger discloses the creation of spherical and spherical polyhedral skeletal animal toys constructed of various rubber materials. In column 6, Willinger discloses the use of a rubber reinforced with carbon black. However, there is no motivation to combine Willinger with any of the foregoing references. Moreover, applicant respectfully asserts that Willinger does not overcome the deficiencies of the combination of Cooper and Ou, as described above, and thus the independent claims, from which these claims depend, are not rendered obvious and Willinger fails to provide the necessary teachings to render them obvious.

Moreover, in a particularly preferred embodiment of the present invention, as will be more fully described herein, the animal chew toy which is created has a tire configuration. The use of a tire rubber comprised of natural or synthetic rubber mixed

with carbon black provides the characteristics and appearance of a tire, which is desired in the present invention. This is not taught, suggested, or even inferred in any of the Cooper, Ou, or Willinger references.

Independent claim 21 is allowable for the same reasons as independent claims 1 and 14. Independent claim 21 further recites that the first and second layers of rubber material are a tire rubber material comprised of natural or synthetic rubber mixed with carbon black. Thus, independent claim 21 should be allowable for the same reasons indicated above with respect to claims 3-4 and 15-16.

### **35 U.S.C. §103(a) Rejection of Claims 12 and 20**

Claims 12 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cooper, in view of Ou, and further in view of Edwards (U.S. Patent No. 4,513,014). As described in the Specification, natural rubber mixed with carbon black creates a tire rubber material, which has an unpleasant odor. In order to mask this unpleasant odor, a scent, such as peppermint or the like, is added to the rubber material during the manufacturing process. In Edwards, the chewable toy for the animal is shaped to simulate a dog bone and a surface-migrating flavoring pleasing to the animal is mixed with the material comprising the toy during manufacturing. Moreover, applicant respectfully asserts that Edwards fails to provide the deficiencies in the combination of Cooper and Ou, as described above, thus the independent claims 1 and 14, from which these claims depend, are not obvious, and claims 12 and 20 should also be allowable for the same reasons as independent claims 1 and 14.

### **35 U.S.C. §103(a) Rejection of Claim 25**

Claim 25 was rejected under the combination of Cooper, in view of Ou, and further in view of Willinger and Edwards. However, as described in the Specification of the present application, and more particularly on page 5, line 25 - page 6, line 5, as the sheets of rubber material are preferably comprised of a tire rubber material, such as natural or synthetic rubber mixed with carbon black, which has a unique and strong smell which might deter some dogs from using the chew toys created by the rubber material, in a preferred embodiment, a scent is added to the rubber material to mask the strong odor of the rubber material and so as to be pleasant to the animal. Edwards teaches of a flavoring which can migrate to the surface of the chew toy so as to replenish the flavoring which has been removed, such as due to licking, chewing, etc. Moreover, the flavoring can be scented so as to mimic meat, bone, etc. such that the dog believes that the animal chew toy, such as the illustrated bone of Edwards, tastes and smells like a bone or other desirable material. There is no discussion whatsoever in Cooper, Ou, Willinger or Edwards of using a scent to mask the strong odor of the tire rubber material which might be unpleasant to the animal. Moreover, as described above, neither Willinger nor Edwards provides the deficiencies in the combination of Cooper and Ou, as described above, and thus dependent claim 25 should be allowable for the same reasons as indicated above with respect to independent claim 21.

### **35 U.S.C. §103(a) Rejection of Claims 7-11 and 17-19**

Claims 7, 9-11, 17 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Cooper, in view of Ou, and further in view of Markham et al. (U.S.

Patent No. 5,904,118). Moreover, claims 8 and 18 were rejected under this same combination of references.

In the final Office Action, it was argued by the Examiner that it would have been obvious for one of ordinary skill in the art to have formed a pet chew toy having a rope and a buoyant insert made from a closed-cell foam inserted into a cavity of said toy as taught by Markham et al. using the process of Cooper in view of Ou because, Markham et al. teach that such a pet toy provides for an improved product by permitting increased visibility when pets play in the water. Moreover, the Examiner asserted that it would have been obvious for one of ordinary skill in the art to have formed a pet chew toy having an animal treat retained in the cavity therein as taught by Markham using the process of Cooper in view of Ou because, Markham et al. teach that such a pet toy provides for increased life by allowing the pet to use said toy for an increased period of time, hence providing for an improved product.

In the present invention, the animal chew toy comprised of the compressed rubber layers and embedded floss sheet material do not float. Thus, a buoyant insert may be inserted into a cavity of the toy so as to render it buoyant. Including a rope attached to the buoyant insert and/or animal chew toy enables the animal chew toy to be thrown, enables the animal and user to play tug-of-war and the like.

However, applicant respectfully asserts that there is no motivation to combine the teachings of Markham et al. with Cooper and Ou. More particularly, there would be no motivation to attach a rope to the flying disc of Cooper, as this would destroy its aerodynamic abilities and utility. Moreover, the Cooper flying disc does not have a

cavity in which to insert anything, let alone an animal treat. Furthermore, the Cooper core itself is comprised of closed-cell neoprene, which is waterproof and which is buoyant. There would be no object or purpose of associating a buoyant insert with the Cooper flying disc. As recited in claim 11, the buoyant insert comprises a closed-cell foam in the present invention, whereas the Cooper flying disc itself has a core comprised of closed-cell foam material. Thus, applicant respectfully submits that claims 7-11 and 17-19 are patentably distinct from the proposed combination of Cooper, Ou, and Markham et al. as there is no suggestion or motivation to combine the teachings of these references, absent the teachings of the present invention; and furthermore, these references fail to teach all of the claim limitations of these claims.

**35 U.S.C. §103(a) Rejection of Claims 22-24**

Claims 22-24 were rejected as being unpatentable over Cooper in view of Ou and further in view of Willinger and Markham et al. Independent claim 21 recites that the first and second layers are comprised of a tire rubber material comprised of natural or synthetic rubber mixed with carbon black. Thus, the Willinger reference has been added to Cooper, Ou and Markham et al., otherwise the same reason applies to both the rejection, as well as applicant's arguments with respect to the rejection of claims 7-11 and 17-19. More particularly, applicant respectfully submits that the combination of references lacks suggestion or motivation when considering the references alone, without the benefit of the teachings of the present invention; and the combination of references fail to disclose all of the claim limitations of these claims.

### **35 U.S.C. §103(a) Rejection of Claim 13**

Claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Cooper in view of Ou and further in view of Richards (U.S. Patent No. 5,020,808). More particularly, in the Office Action, it is asserted that “it would have been obvious for one of ordinary skill in the art to make a tire shaped flying disc (animal chew toy) as taught by Richards (‘808) using the process of Cooper (‘214) in view of Ou (‘082) because Richards (‘808) teaches that an annular (tire) shape provides for improved performance, hence providing for an improved product.”

Richards is directed to a tossing ring utilizing a pair of annular bodies superimposed on one another such that the end surface of one of the annular bodies extends further outwardly from the openings of the other annular body(ies). Two or three annular bodies are stacked upon one another in such offset arrangement to create the tossing ring of Richards. The overlapping annular bodies are adhered to one another, such as by using glue. Richards discusses that this arrangement exhibits aerodynamically stable flight, and exhibits great aesthetic appeal.

In the Office Action, the Examiner asserts that Richards teaches a tire shaped flying disc (animal chew toy). However, applicant respectfully disagrees with this assertion. Aside from being generally circular, the Richards tossing ring arrangement has absolutely no appearance or configuration resembling that of a tire.

Moreover, applicant respectfully asserts that there is no suggestion or motivation in the references themselves to make the combination that the Examiner has proposed, without the benefit of hindsight reasoning of the applicant’s teachings and claims. It is

insufficient that the prior art discloses the components of the patented device, either separately or used in other combinations, there must be some teaching, suggestion, or incentive to make the combination made by the inventor. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988) (insufficient to select from the prior art the separate components of the inventor's combination, using the blue-print supplied by the inventor); *Rosemount, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 1546, 221 USPQ 1, 7 (Fed. Cir. 1984) ("As this court has held, 'a combination may be patentable whether it be composed of elements all new, partly new or all old'" (citations omitted); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 220 USPQ 303, 312 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (individual references can not be "employed as a mosaic to recreate a facsimile of the claimed invention.") Thus, applicant respectfully submits that claim 13 is not rendered obvious by the combination of Cooper, Ou, and Richards.

### **35 U.S.C. §103(a) Rejection of Claims 26 and 27**

Claims 26 and 27 were rejected as being unpatentable over Cooper in view of Ou and Richards, and further in view of Mitchell (U.S. Patent No. 4,906,007) and Farhi (U.S. Patent No. 3,673,731). In the final Office Action, the Examiner incorrectly states that Cooper and Ou and Richards teach the basic claimed process of claims 13 and 14. However, the Examiner admits that Cooper in view of Ou and Richards are silent as to spaced apart sidewalls extending inwardly from the outer periphery to define generally aligned central apertures, the periphery and the sidewalls having a generally U-shaped

cross-section, and the outer periphery including a tread design formed over at least a portion thereof.

The Examiner asserts that, "However, Farhi teaches that a disc having generally aligned central apertures (Fig. 2, item 16, 18) and a U-shape section with sidewalls (Fig. 2, item 14). Mitchell teaches an outer periphery having a design that is intended to be a tread design formed over at least a portion thereof (Fig. 6, items 30 and 34), and defining a central aperture (Fig. 6, item 22). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the methods of Farhi and Mitchell into that of Cooper, Ou, and Richards in order to provide (a) improved airfoil configuration (Farhi, 2:65) and (b) a gripping portion and aerodynamic shape (Mitchell), which would have been desirable to Cooper."

Applicant respectfully submits that neither Farhi et al. nor Mitchell et al. disclose an animal chew toy having a tire configuration, even in the general sense. More particularly, both Farhi et al. and Mitchell et al. disclose what one of ordinary skill in the art would refer to as a disc. Neither Farhi et al. nor Mitchell et al. disclose an outer periphery having spaced apart sidewalls extending inwardly therefrom to define generally aligned central apertures. Instead, Farhi et al. and Mitchell et al. have a single domed surface defining a single central aperture. There are no spaced apart sidewalls extending from an outer periphery to define generally aligned central apertures. Nor do the periphery and the sidewalls have a generally U-shaped cross-section, as recited in claims 26 and 27.



Moreover, applicant respectfully asserts that there is no motivation to combine the teachings of Farhi et al. and/or Mitchell et al. with Cooper, Ou, and Richards, in the manner proposed by the Examiner, to arrive at the present invention. The burden is on the Examiner to particularly identify the suggestion, teaching, or motivation in the reference(s) for their combination, and not just naming similarities between the reference(s) and the claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000), 57 USPQ 2d 1161, 1166; *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), 50 USPQ 2d 1614, 1618.

"[A] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."

*Ecolochem Inc. v. Southern California Edison*, 56 USPQ 2d 1065, 1076 (Fed. Cir. 2000) quoting *In re Rouffett*, 149 Fed. 3d 1350, 1357 (Fed. Cir. 1998), 47 USPQ 2d 1453, 1456.

Moreover, it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention, and the Examiner must avoid the "insidious effect of a hindsight syndrome wherein only that which the inventor taught is used against the teacher". *W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552, 1553, 220 USPQ 303, 312, 313 (Fed. Cir. 1988). The Examiner's

assertions are not supported by the references, but are impermissible hindsight based upon the teachings of Applicant's invention.

"When prior art references require selective combination...to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself..."

*Uniroyal Inc. vs. Rudkin-Wiley Corp.* 5 USPQ 2d 1434, 1438 (Fed. Cir. 1988).

Once again, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970)). From the foregoing, applicant respectfully submits that the combination of Cooper, Ou, Richards, Farhi and Mitchell fail to disclose all of the claim limitations of claims 26 or 27.

From the foregoing, applicant respectfully submits that claims 26 and 27 are not rendered obvious and unpatentable over the combination of Cooper, Ou, Richards, Farhi and Mitchell. More particularly, the references lack the suggestion and motivation within themselves to be combined as proposed by the Examiner. Moreover, the Examiner has impermissibly used hindsight reasoning in reconstructing the claims of the present invention. Finally, these references fail to disclose all of the claim limitations of claims 26 and 27. Thus, these rejections should be withdrawn.

From the foregoing amendments and remarks, applicant respectfully asserts that the currently pending claims (1, 3-5, and 7-27) are in condition for allowance, notice of which is hereby respectfully requested.

## **VIII. CLAIMS APPENDIX**

1. A method for manufacturing an animal chew toy, comprising the steps of:  
providing first and second layers of rubber material formed in a general shape and size of the animal chew toy;  
placing a floss material comprising at least one mesh fabric sheet of synthetic fibers formed in a general shape and size of the animal chew toy between the first and second layers of rubber material; and  
molding the sheets of rubber and floss material into the animal chew toy;  
wherein the molding step includes the steps of compressing the sheets of rubber and floss material between opposing mold members under pressure and heat.
3. The method of claim 1, wherein the rubber material comprises a tire rubber material.
4. The method of claim 3, wherein the tire rubber material comprises natural or synthetic rubber mixed with carbon black.
5. The method of claim 1, wherein the synthetic fibers of the mesh fabric comprise nylon or polyester fibers.
7. The method of claim 1, including the step of attaching a rope to the animal chew toy.
8. The method of claim 1, including the step of retaining an animal treat in a cavity of the animal chew toy.
9. The method of claim 1, including the step of associating a buoyant insert with the animal chew toy.

10. The method of claim 9, wherein the associating step comprises the step of inserting the buoyant insert into a cavity of the animal chew toy.

11. The method of claim 9, wherein the buoyant insert comprises a closed cell foam.

12. The method of claim 1, including the step of adding a scent material to the first and second layers of rubber.

13. The method of claim 1, wherein the animal chew toy is of a tire configuration and having a diameter of between six inches and ten inches, and wherein the tire animal chew toy does not include imbedded metal therein.

14. A method for manufacturing an animal chew toy, comprising the steps of:  
providing first and second layers of a tire rubber material cut into a general shape or size of the animal chew toy;

placing a floss material comprising a synthetic fiber mesh cut into the general shape or size of the animal chew toy between the first and second layers of rubber material; and

compressing the first and second layers of rubber and floss material under pressure and heat to mold the first and second layers of rubber and floss material into the animal chew toy.

15. The method of claim 14, wherein the tire rubber material comprises natural or synthetic rubber mixed with carbon black.

16. The method of claim 14, wherein the synthetic fibers of the mesh fabric comprise nylon or polyester fibers.

17. The method of claim 14, including the step of attaching a rope to the animal chew toy.

18. The method of claim 14, including the step of retaining an animal treat in a cavity of the animal chew toy.

19. The method of claim 14, including the step of associating a buoyant insert within a cavity of the animal chew toy.

20. The method of claim 14, including the step of adding a scent to the layers of rubber.

21. A method for manufacturing an animal chew toy, comprising the steps of:  
providing first and second layers of a tire rubber material comprised of natural or synthetic rubber mixed with carbon black and cut into a general shape or size of the animal chew toy;

placing a sheet of floss material comprising a nylon or polyester fiber mesh cut into the general shape or size of the animal chew toy between the first and second layers of rubber material; and

compressing the sheets of rubber and floss material under pressure and heat to mold the rubber and floss material into the animal chew toy.

22. The method of claim 21, including the step of attaching a rope to the animal chew toy.

23. The method of claim 21, including the step of retaining an animal treat in a cavity of the animal chew toy.

24. The method of claim 21, including the step of associating a buoyant foam insert within a cavity of the animal chew toy.

25. The method of claim 21, including the step of adding a scent material to the layers of rubber.

26. The method of claim 13, wherein the tire configuration includes an outer periphery having a tread design formed over at least a portion thereof, and spaced apart sidewalls extending inwardly from the outer periphery to define generally aligned central apertures, the periphery in the sidewalls having a generally U-shaped cross-section.

27. The method of claim 14, wherein the animal chew toy is compressed into a tire configuration having an outer periphery including a tread design formed over at least a portion thereof, and spaced apart sidewalls extending inwardly from the outer periphery to define generally aligned central apertures, the periphery and the sidewalls having a generally U-shaped cross-section, the animal chew toy being devoid of metal.

**IX. EVIDENCE APPENDIX**

None.



**X. RELATED PROCEEDINGS APPENDIX**

None.

Respectfully submitted,

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